

REMARKS

The Office Action of June 16, 2006 requires an election under 35 U.S.C. § 121 from among the following:

- I. Claims 1-10 and 27-29 (in part), drawn to methods of producing viruses utilizing an avian cell line comprising avian cells that are immortalized but untransformed and which comprise an anti-apoptotic bcl-2 gene in their genome, classified in class 435, subclass 235.1,
- II. Claims 11-19, drawn to untransformed, immortalized avian cells that contain a nucleic acid molecule encoding an anti-apoptotic protein, classified in class 435, subclass 349,
- III. Claims 20-23, drawn to untransformed, immortalized avian cells that contain a nucleic acid molecule encoding an anti-apoptotic protein and a heterologous nucleotide sequence, classified in class 435, subclass 235,
- IV. Claims 24-26, drawn to untransformed, immortalized avian cells that contain a nucleic acid molecule encoding an anti-apoptotic protein and further infected by a virus, classified in class 435, subclass 325,
- V. Claims 27-29 (in part), drawn to methods of producing viruses utilizing an avian cell line comprising avian cells that are immortalized but untransformed and which comprise an anti-apoptotic gene other than the bcl-2 gene in their genome, classified in class 435, subclass 235.1,
- VI. Claims 30-33, drawn to methods of producing a viral peptide, protein or glycoprotein utilizing untransformed, immortalized avian cells that contain a nucleic acid molecule encoding an anti-apoptotic protein, classified in class 435, subclass 69.1.

Group II, claims 11-19, is elected with traverse for further prosecution in this application.

Applicants reserve the right to file divisional applications to non-elected subject matter.

The Office Action further required election of an anti-apoptotic protein.

The Applicant elects the bcl-2 protein, with traverse.

As a traverse, it is noted that the MPEP lists two criteria for a proper restriction requirement. First, the inventions must be independent or distinct. (MPEP § 803) Second,

searching the additional inventions must constitute an undue burden on the Examiner if restriction is not required. *Id.* The MPEP directs the Examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ...even though it includes claims to distinct or independent inventions.” *Id.*

It is respectfully submitted that the criteria listed in MPEP § 803 have not been met in this case, as no showing has been made that an undue burden would be placed on the Examiner. The present application relates to immortalized, untransformed avian cells which contain a nucleic acid molecule encoding an anti-apoptotic protein and are resistant to apoptosis, and methods for either producing viruses which utilize these cells, or using these cells to produce viral peptides, proteins, or glycoproteins. Accordingly, there is a relationship among the methods and cells disclosed in the present invention.

Indeed, any search for the methods of group I would certainly be co-extensive with the claims of groups II and IV, as the cells described in group II and the viral-infected cells described in group IV are essential to the methods of claim 1. As stated by the Examiner, the claims of Group 1 are drawn to “method of producing viruses utilizing an avian cell line comprising avian cells that are immortalized but untransformed...” The Examiner admits that the claims of Group II are “drawn to untransformed, immortalized avian cells,” which is a component of part (i) of claim 1. Moreover, the claims of Group IV are “drawn to untransformed, immortalized avian cells...and further infected by a virus,” which is a component of part (iii) of claim 1. Thus, the search for the methods of Group 1 would inherently require examination of the cells in Groups II and IV. In addition, the relation among Groups I, II and IV is further indicated by their classification in the same class. Therefore, the examination of Groups I, II, and IV would not place undue burden on the Examiner.

Furthermore, the Applicants respectfully traverse the election of species. In view of M.P.E.P. §803, a requirement for election is inappropriate when the generic claim includes sufficiently few species that a search and examination of all the species at one time would not impose a serious burden on the examiner. For the present application, the number of anti-apoptotic proteins to be searched is low, and all of these proteins are interrelated as they share a similar function. Thus, the Applicant respectfully requests the Examiner to withdrawal the election of species.

Enforcing the present restriction requirement and election of species would result in inefficiencies and unnecessary expenditures by both the Applicants and the PTO, as well as extreme prejudice to Applicants (particularly in view of GATT, a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper, especially since the requisite showing of serious burden has not been made in the Office Action and there are relationships between the claimed combinations. Indeed, the search and examination of at least groups would involve such interrelated art that the search and examination of at least groups I, II, and IV can be made without undue burden on the Examiner. All of the preceding, therefore, mitigate against restriction.

In view of the above, reconsideration and withdrawal of the Requirement for Restriction and election of species are requested, and an early action on the merits earnestly solicited.

Respectfully submitted,

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